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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,876	12/12/2001	Eileen White	RUT 98-0058	5628

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EXAMINER

YU, MISOOK

ART UNIT PAPER NUMBER

1642

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/674,876

Applicant(s)

WHITE ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): 112, Second Paragraph.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-3.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Misook Yu, 12-15-2003

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant's main argument of non-obviousness of the instantly claimed invention over the art of record is that the art does not recognize inhibition of p300/CBP activity can induce apoptosis. This argument has been fully considered but found unpersuasive because claims 1 and 2 are drawn to recombinant cells per se, and no need for one of ordinary skill to recognize inhibition of p300/CBP activity can induce apoptosis in order to arrive at the instantly claimed invention. As for claim 3, the art of record teaches p300/CBP alone does not have any *in vivo* biological significance, therefore applicant's argument that the art does not provide motivation to screen useful compounds that target p300/CBP is not convincing. The art teaches that transcription activation involves multiple proteins complex. The main point of Arany et al is determination of involvement of p300/CBP in transactivation of important genes for tumor development (see the line of the abstract), thus suggesting p300/CBP might be important target for regulation of tumor development and apoptosis. The instant invention uses cells and plasmids that are known in the art well before the effective filing date of instant application to screen candidate compounds that might be useful in treating diseases. The art as a whole teaches that p300/CBP might be a target for intervention of tumor development because p300/CBP forms complex with p53 implicated in many different tumors. US Pat 5,607,967 is cited to show that current state of art using transactivation of reporter gene as a simple way of screening useful compounds when the *in vivo* target acts as transcription regulator. It is the Office's position that screening useful compounds with art-known technology and/or reagents would have been obvious to one of ordinary skill to practice the instantly claimed invention with reasonable expectation of success.

Applicant also argues that Gurtu et al fail to teach the creation of a stable cell line containing two or more plasmids containing two or more antibiotic resistance genes for selection. This argument is also fully considered but found unpersuasive because the argument is considered not commensurate in scope of the instant claims because the claims do not say "two or more antibiotic resistance genes for selection". Rather the claims require 3 plasmids, first plasmid expressing a p300/CBP responsive promoter operatively linked to a first reporter gene; a second plasmid expressing a non p300/CBP responsive promoter operatively linked to a second reporter gene; a third plasmid expressing a selection marker.

Applicant argues that the recombinant cells of the primary references are transiently transfected, therefore not an obvious reference and the primary references teach only one reporter gene and applicant further argues that stably transfected cells with two promoter-reporter gene constructs. These arguments have been fully considered but found not persuasive because if a single reference does not have to teach every element in order to be an obvious reference, if a single reference teaches every element, then it would be a 102 reference, not a 103 reference. The art of record as a whole teaches every element of instant claims. The instant claims require 3 plasmids; first plasmid expressing a p300/CBP responsive promoter operatively linked to a first reporter gene and Gu et al teach mdm2-luciferase; a second plasmid expressing a non p300/CBP responsive promoter operatively linked to a second reporter gene and Lill et al teach MG15-CAT; a third plasmid expressing a selection marker and Gurtu et al teach that stable transfection of mammalian cells is a widely used technique before the effective filing of the instant application, and an antibiotic selective marker is necessary for selection of clones with desirable stable transfection and/or maintaining selective pressure during clonal expansion. Screening potentially useful compounds using reporter gene has been taught by the cited patent. See the first paragraph above. Therefore, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to practice the invention with reasonable expectation of success.

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